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09/892,897	06/28/2001	Peter Kight	3350-89	1588

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EXAMINER

KRAMER, JAMES A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,897

Applicant(s)

KIGHT ET AL.

Examiner

James A. Kramer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52, as interpreted by the examiner are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in US Patent number 6,173,272 (Thomas).

Thomas teaches trusted third party data structure for electronic funds transfer and bill presentment. Thomas teaches a bank (or financial service provider) with a network of customers (or payors and payees). Thomas teaches as old and well known in the art for a payor from one bank (financial service provider) to want or have to make a payment to a payee belonging to another bank (or a second financial service provider). As such this payee will belong to a second banking network. Thomas teaches that the automated clearing house network (ACH) is a low-cost electronic payment mechanism to make payments between banking networks (i.e. from one bank to another) (column 7; line 65 – column 8; line 5). Examiner makes special note that this system speaks directly to Applicant's claim language of a payment network including payors and payees. Based on the broadest definition of this limitation a "home banking system with customers" is in fact Applicant's "payment network with a plurality of associated payors and payees".

Thomas further teaches receiving a request to make a payment on behalf of a payer to a payee, transmitting a request to find the banking network payee belongs to, receiving information about the banking network of payee and transmitting payment information (column 4; lines 35-55). Thomas teaches utilizing a trusted third party (TTP, in this situation examiner interprets the TTP to be synonymous with Applicant's inter-network directory provider) to locate the payee. The TTP uses a unique identifier that identifies the payee when given at least payee's name and address and associates all information about the payee (column 8; lines 47-49 and 56-57). Once association is made the TTP identifies if the transaction will be accepted or not and

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facilitates the transaction by providing remittance advice. The unique identifier is saved in a database of the TTP and can be used to make other payments to the payee on behalf of the original payer or alternative payers. One of the key objectives of a TTP protocol is to provide secured communications for both payer and payee (column 3; line 65 – column 4; line 5).

Thomas further teaches TTP software available over a network or provided locally. The TTP database houses appropriate deposit and supported transaction types for each of the payees and payers. Also the payment/electronic fund transfer message is sent as a second message set, separate from the original association message or remittance advice.

Thomas does not specifically teach that the payee and the payer are on different payment networks. However, as address previously by Examiner Thomas clearly supports inter-bank transfers via the ACH network in order to provide a low-cost mechanism to efficiently pay individual customers regardless of size (column 7; lines 65 – column 8; line 2). As such it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the system of Thomas to transfer funds from a payor on a first banking network to a payee on a second banking network via the ACH network in order to provide a low-cost mechanism to efficiently pay individual customers.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-10, 27, & 31-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53-72 of copending Application No. 09/984,568. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims recite the same method. The same system and method is used in both applications with only the intended usage distinguishing them. As such, the intended use of the product does not make the inventions patentably distinct. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

Applicant's arguments filed 3-20-03 have been fully considered but they are not persuasive.

Applicant argues that the rejection is improper on its face, as it has been made in omnibus fashion. Applicant further directs Examiner's attention to MPEP 707.07(d), A plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the groups. Examiner believes that the rejection is in fact applicable to all the claims in the groups.

Applicant asserts that obviousness is unsupported by the required factual determination and accordingly cannot be reasonably understood. Examiner does not agree. Examiner believes that the references clearly support the factual determination of obviousness. As such, the Examiner has made an effort to more clearly state the motivation to combine in the above rejection.

Applicant asserts that the transmission of payment instruction, as required by claim 1 is not made obvious by the recitals of claims 53 of the '568 application. Examiner disagrees and turns Applicant's attention to the cited prior art, US Patent number 6,173,272 (Thomas). Thomas teaches a system and method used for both fund transfers and bill presentment. The reference illustrates that it is old and well known in the art that it is in fact obvious to use the same method to send a payment instruction as an instruction to present a bill.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3687 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

James A. Kramer  
Examiner  
Art Unit 3627

JAK  
May 21, 2003

  
Kenneth R. Rice  
Primary Examiner